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DOCKET NO. SHAM02-00010

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: : Ronald J. MacNeil
Assignee of Patent : Shamrock Lacrosse, Inc.
Patent Number : RE 37,894 E
Date of Reissue : October 22, 2002
For : LACROSSE STICK HEAD
Reissue of : U. S. Patent No. 5,494,297
Issued February 27, 1996
Application No. 08/285,125
Filed August 2, 1994

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OFFICE OF PETITIONS

MAIL STOP PETITION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

**PETITION FOR RECONSIDERATION OF DECISION REFUSING TO ACCEPT
DELAYED PAYMENT OF MAINTENANCE FEE (37 C.F.R. §1.378(e))**

Pursuant to the provisions of 37 C.F.R. §1.378(e), Shamrock Lacrosse, Inc. (the "Petitioner") respectfully petitions the Commissioner to reconsider the 11 January 2008 Decision in which the Commissioner dismissed the Petitioner's 5 September 2007 petition to accept delayed payment of the maintenance fees in reissue patent RE 37,894 E ("Reissue Patent RE 37,894").

The Petitioner claims Small Entity Status for the purpose of payment of all fees. The Petitioner encloses herewith the \$400.00 fee required under §1.378(e) for this petition.

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REMARKS

In the 11 January 2008 Decision on Petition, it was asserted that the Petitioner failed to show unavoidable delay in the 5 September 2007 Petition, because no evidence was provided to establish that the delay by the firm charged with payment of the maintenance fee was unavoidable. The 11 January 2008 Decision also reminded the Petitioner that, in the absence of an adequate showing of the diligence of the law firm(s) handling the payment of the maintenance fees, the action or inactions of the registered practitioners are imputed to the Petitioner. The Decision stated that the Petitioner must make a documented showing that the entire delay was unavoidable and that any such showing must include a statement from the principals responsible for payment of the maintenance fees (i.e., the law firms that represented the Petitioner) as to why action was not taken to timely submit the required maintenance fee while the patent was under their control.

The Petitioner respectfully disagrees with the Decision on Petition and, in particular, with the specific requirement that a documented showing that the entire delay was unavoidable must include a statement from the law firms that represented the Petitioner as to why action was not taken to timely submit the required maintenance fee while the patent was under their control. As the Commissioner is no doubt aware, decisions on revival (or reinstatement) are made on a "case-by-case basis, taking all the facts and circumstances into account." *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). See also MPEP §711.03(c). The Petitioner respectfully

asserts that the specific facts and circumstances of the present case favor reinstatement of Reissue Patent RE 37,894.

As noted in the Statement of Peter Rogers submitted with the 5 September 2007 Petition, it is the opinion of Mr. Rogers that Attorney Scott Fields, who handled the payment of maintenance fees for Reissue Patent RE 37,894 and/or one or more of the law firm(s) in which he was employed may have purposely concealed from the Petitioner the facts concerning the nonpayment of the Reissue Patent RE 37,894 maintenance fees in order to avoid a claim of legal malpractice. It is further noted that Attorney Scott Fields died in April 2007, and that prior to his death, Mr. Fields was unwilling to cooperate in the reinstatement of Reissue Patent RE 37,894 due to a potential malpractice claim against one or more of Mr. Fields, the Klehr Harrison law firm, the Obermeyer Rebmann law firm, and the National IP Rights Center law firm. The Klehr Harrison law firm, the Obermeyer Rebmann law firm, and the National IP Rights Center law firm are also unwilling to cooperate in the reinstatement of Reissue Patent RE 37,894.

Petitioner respectfully asserts that if the specific facts and circumstances of the present case are properly taken into account, reinstatement of Reissue Patent RE 37,894 is justified. It is fundamentally unfair to require the Petitioner to obtain a statement from Mr. Scott Fields (now deceased) or his former law firms due to the potentially adverse relationship of those other parties to the Petitioner. The Petitioner, for its own part, has exercised that level of care or diligence that is generally used and observed by prudent and careful businesspeople in relation to their most

important business. See *In re Mattullath*, 38 App. D.C. 497, 514-15 and *Winkler v. Ladd*, 221 F. Supp. 550, 552, (D.D.C. 1963). See also MPEP §711.03(c), p. 700-202. The Petitioner asserts that fairness dictates that Reissue Patent RE 37,894 be reinstated.


The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS CARTER, P.C.

Date: 11 March 2008

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